

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte Robert C. Brown

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Appeal No. 2005-0263  
Application No. 10/314,766

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ON BRIEF

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Before GARRIS, WARREN, and PAWLIKOWSKI, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal which involves claims 1 and 4-11.

The subject matter on appeal relates to a soap bar element for minimizing the amount of soap remaining on the bar after a few uses comprising a non-soap central core and a soap shell surrounding the core wherein the core occupies at least 75 volume

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percent of the bar element. This appealed subject matter is adequately illustrated by independent claim 1 which reads as follows:

1. An economical soap bar element for minimizing the amount of soap remaining on the bar after a few uses, comprising a non-soap central core and a soap shell surrounding said non-soap core in at least two dimensions, wherein said non-soap core occupies at least about 75 volume percent of said bar element.

The references set forth below are relied upon by the examiner as evidence of obviousness:

Allen	3,796,665	Mar. 12, 1974
Hadley et al. (Hadley)	3,969,256	Jul. 13, 1976
Di Giovanna	4,308,157	Dec. 29, 1981

Claims 1 and 4-9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hadley.

Claims 1 and 4-11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either Allen or Di Giovanna.

For a complete exposition of the opposing viewpoints expressed by the appellant and by the examiner concerning the above noted rejections, we refer to the brief and to the answer as well as the Office action mailed January 20, 2004.

As a preliminary matter, we observe that, in the "Grouping of Claims" section of the brief (i.e., see pages 4-5), the appellant indicates that the claims do not stand or fall

together. However, in the "Argument" section of the brief (i.e., see pages 5-13), the appellant has not presented any arguments reasonably specific to any of the dependent claims 4-11. In this regard, it is important to appreciate that, in order to have commonly rejected claims separately considered, the claims not only must be grouped separately but also must be argued separately. See 37 CFR § 41.37(c)(1)(vii)(September 2004); formerly 37 CFR § 1.192(c)(7)(2003). Also see Ex parte Schier, 21 USPQ2d 1016, 1018 (Bd. Pat. App. & Int.). Because these dependent claims have not been argued separately on this appeal, they will stand or fall with independent claim 1 which is the sole independent claim before us. See In re Dance, 160 F.3d 1339, 1340, n.2, 48 USPQ2d 1635, 1636, n. 2 (Fed. Cir. 1998).

#### OPINION

For the reasons which follow, we will sustain each of the rejections advanced on this appeal.

As correctly observed by the examiner (and not disputed by the appellant), appealed independent claim 1 distinguishes from each of Hadley, Allen and Di Giovanna in that none of these references expressly teaches the here claimed limitation "wherein said non-soap core occupies at least about 75 volume percent of said bar element." More particularly, these references contain

no express teaching whatsoever regarding the core size or volume of the soap bar elements respectively disclosed therein.

Nevertheless, the examiner concludes that it would have been obvious for one with ordinary skill in this art to size the core in each of Hadley, Allen and Di Giovanna such that it occupies at least about 75 volume percent of the bar element as required by the independent claim on appeal.

The examiner has presented a variety of rationales in support of this obviousness conclusion, some of which are of questionable merit.<sup>1</sup> Regardless, we consider as well taken the examiner's fundamental position that the applied reference disclosures would have suggested a range of core sizes including the here claimed size of at least 75 volume percent. For example, as correctly indicated by the examiner on page 6 of the answer, Figures 2 and 3 of Allen cumulatively disclose a core size that either is within, or at least would have suggested, the here claimed range of at least 75 volume percent. In re Meng,

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<sup>1</sup>Specifically, in the January 20, 2004 Office action, the examiner has cited In re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947) for the proposition that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish a claimed invention from the prior art. This citation quite plainly is inapposite to the case before us since the appealed claim 1 feature under consideration unquestionably performs a function and therefore does not relate to ornamentation only.

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492 F.2d 843, 847, 191 USPQ 94, 97 (CCPA 1974)(a drawing is available as a reference for all that it teaches a person of ordinary skill in the art). Moreover, it is appropriate to regard the aforementioned absence of an express core size teaching in these references as supporting an obviousness conclusion. This is because this absence of express teaching evinces that the determination of suitable core sizes would have been within the capabilities of those with ordinary skill in this art.

In this last mentioned regard, the appellant argues that the applied references contain no suggestion of core sizes within the here claimed range because his claimed invention is directed to problems and characteristics which are different from those of the applied prior art. We cannot agree for a number of reasons. First, this argument is contrary to the above discussed drawing disclosure of Allen. Additionally, we are unpersuaded by the appellant's argument because we disagree with the proposition on which it is based. That is, we do not agree with the appellant's position that the here claimed soap bar element involves problems and characteristics which are incompatible with the soap bar elements of the applied prior art.

For example, the subject specification discloses that the appellant's soap bar element is economical by reducing residual soap waste and by using an inexpensive non-soap core (e.g., see lines 5-11 on page 1, lines 3-9 on page 3 and lines 1-8 on page 6). Corresponding objectives are disclosed in the applied references. By way of exemplification, the Abstract and lines 16-23 in column 1 of Hadley disclose reducing soap waste, and the use of inexpensive core materials is disclosed by Allen (see lines 4-9 in column 2) as well as by Di Giovanna (see lines 2-10 in column 2). The fact that the applied references disclose objectives corresponding to those disclosed by the appellant supports the examiner's conclusion that the respective reference disclosures would have suggested soap bar elements having core sizes within the appellant's claimed range.

Finally, the appellant argues that his nonobviousness position is supported by additional considerations such as a long felt but unsatisfied need (e.g., see pages 10-12 of the brief). However, the record before us contains no probative evidence of such additional considerations as a long felt but unsatisfied need vis-à-vis reducing wastage of soap bars used in hotels. On the other hand, the soap bar of Allen is explicitly disclosed as

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being for use in a hotel (see Figure 1) and therefore appears to have satisfied the need referred to by the appellant.

In light of the foregoing, it is our ultimate determination that the reference evidence adduced by the examiner establishes a prima facie case of obviousness which the appellant has failed to successfully rebut with argument or evidence of nonobviousness. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Accordingly, we hereby sustain the examiner's section 103 rejections of claims 1 and 4-9 as being unpatentable over Hadley and of claims 1 and 4-11 as being unpatentable over either Allen or Di Giovanna.

The decision of the examiner is affirmed.

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No time period for taking any subsequent action in  
connection with this appeal may be extended under 37 CFR  
§ 1.136(a).

AFFIRMED

Bradley R. Garris	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
Charles A. Warren	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
Beverly A. Pawlikowski	)	
Administrative Patent Judge	)	

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